

Serial No. 10/054,257

Amend. In Resp. to Office Action of Dec. 19, 2005

UTILITY PATENT

B&D No. TN -2239

Amendments to the Drawings:

The attached sheets of drawings include changes to FIGS. 2, 10 and 14-15. These sheets, which include FIGS. 1-16, replace the original sheets including FIGS. 1-16.

Attachment: Replacement Sheets

Serial No. 10/054,257

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REMARKS

Applicants have amended Claim 1 and canceled Claims 11-12. Currently in the application therefore are Claims 1-7, 9-10 and 13-16.

The Examiner objected to the specification under 37 CFR § 1.71 because "it is unclear how the sliding fence 22 can slide on the surface of the fixed fence 21." Applicants note that the Specification reads: "Persons skilled in the art are hereby referred to US Patent No. 5,297,463, which is hereby wholly incorporated by reference." Specification, para. 0025. Under MPEP § 2163.07(b), information incorporated by reference "is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed." Being that US Patent No. 5,297,463 fully describes one possible slidable fence and it is considered part of the present specification, Applicants submit that the structure of sliding fence 22 and fixed fence 21 is fully explained.

The Examiner objected to the drawings for failing to comply with 37 CFR § 1.81. In particular, the Examiner noted that some of the dash lines in FIG. 2 are unclear. Applicants have amended FIG. 2 to show that some dash lines show the insertion movement of wear ring 14, whereas the others show the position of wear ring 14 when inserted into channel 11C.

Furthermore, the Examiner noted that it was unclear "what the bottom surface of the table looks like so that it can accommodate the wearing ring" and requested a perspective view of such drawing. Applicants submit that such drawing is not necessary as table 12 is disposed on top of

Serial No. 10/054,257

Amend. In Resp. to Office Action of Dec. 19, 2005

UTILITY PATENT

B&D No. TN -2239

wear ring 14. Accordingly, persons skilled in the art will know that table 12 only requires a surface to dispose on wear ring 14.

The Examiner also noted that it was unclear whether FIGS. 14-15 are the front view of FIG. 1 due to some inconsistencies between FIGS. 1 and 14-15. Applicants submit that FIGS. 1 and 14-15 need not be completely consistent as they refer to different embodiments of the invention. Accordingly, no amendment to the drawings is necessary.

The Examiner objected to the drawings for failing to show the sliding fence and the stop fixture called for in Claim 9. Applicants submit that such the sliding fence and stop fixture are denoted in FIG. 14 with reference characters "22" and "F," respectively.

The Examiner rejected Claims 9-10 under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner noted that "it is unclear how the slidable fence can slide on the top surface of the fixed fence." This rejection is respectfully traversed.

As discussed above, the Specification reads: "Persons skilled in the art are hereby referred to US Patent No. 5,297,463, which is hereby wholly incorporated by reference." Specification, para. 0025. Under MPEP § 2163.07(b), information incorporated by reference "is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed." Being that US Patent No. 5,297,463 fully describes one possible slidable fence and it is considered part of the present specification, Applicants submit that the structure of sliding fence 22 and fixed fence 21 is fully explained.

Serial No. 10/054,257

Amend. In Resp. to Office Action of Dec. 19, 2005

UTILITY PATENT

B&D No. TN -2239

The Examiner also rejected Claims 1-7 and 9-10 under 35 USC § 112, second paragraph, as being indefinite.

With respect to Claim 1, the Examiner has noted that "it appears that claim 1 states some portions of the wearing ring being not moveable which is not correct." Applicants request that the Examiner identify which part of wear ring 14 is a movable portion, as Applicants have explicitly stated in Claim 1 and the Specification that wear ring 14 does not have any movable portions.

As to Claim 9, the Examiner noted that "it does not seem the sliding fence [is] slidable with respect to the fixed fence." As explained above, the Specification provides full and clear support for a slidable fence. Thus, Claim 9 properly points out the subject matter of the invention.

As to Claim 10, the Examiner noted that "it is unclear whether 3/16 inches is the unit of the hole's diameter or the hole's depth." Applicants note that paragraph 0039 of the Specification denotes that "hole FFH may have a diameter of about 3/16 of an inch." Pursuant to such teaching, Applicants have amended Claim 10 to read: -- the hole has a diameter of about 3/16 of an inch.--

The Examiner rejected Claim 9 under 35 USC § 102(b) as being anticipated by US Patent No. 5,855,366 ("Chang"). In addition, the Examiner rejected Claim 10 under 35 USC § 103(a) as being unpatentable over Chang. This rejection is respectfully traversed.

Claims 9 calls for a miter saw comprising a base assembly, a table rotatably attached to the base assembly, a saw assembly pivotably attached to the table, a fixed fence attached to the

Serial No. 10/054,257

Amend. In Resp. to Office Action of Dec. 19, 2005

UTILITY PATENT

B&D No. TN -2239

base assembly, and a sliding fence slidably attached to the fixed fence, the sliding fence having at least one hole for fixing an end stop fixture thereto.

Admittedly, Chang discloses a miter saw with a base assembly, a table rotatably attached to the base assembly, a saw assembly pivotably attached to the table, and a fixed fence attached to the base assembly. However, Chang does not disclose a sliding fence slidably attached to the fixed fence. Instead, it discloses a pivotable fence 33 that rotates about boss 35 inserted into hole 215. Fence 33 is moved between first and second positions shown in Chang's FIGS. 4-5, respectively. Therefore, Chang does not disclose a sliding fence.

Furthermore, the pivotable fence does not have at least one hole for fixing an end stop fixture thereto. This is because, if an end stop fixture was affixed to the pivotable fence, the user would not be able to move fence 33 between the first and second positions shown in Chang's FIGS. 4-5 as the end stop fixture would bump into fence portion 214.

By contradistinction, Claim 9 requires "a sliding fence slidably attached to the fixed fence, the sliding fence having at least one hole for fixing an end stop fixture thereto." Since Chang does not disclose such elements, it cannot anticipate Claim 9 or its dependent Claim 10.

The Examiner also rejected Claims 13-16 under 35 USC § 102(b) as being anticipated by US Patent No. 5,778,747 ("Chen"). Reconsideration and withdrawal of this rejection is respectfully requested.

Admittedly, Chen shows a chop saw with a base assembly, and a saw assembly pivotably attached to the base assembly, the saw assembly comprising an upper blade guard, a plate rotatably

Serial No. 10/054,257

Amend. In Resp. to Office Action of Dec. 19, 2005

UTILITY PATENT

B&D No. TN -2239

attached to the upper blade guard, a lower blade guard rotatably attached to the plate, and a screw engaging the upper blade guard for fixing the plate.

Assuming for the sake of argument that the Examiner's interpretation of the "first tab" is appropriate, Chen still does not show a tab extending outwardly and substantially perpendicular from the plate and/or the upper blade guard. Instead, the first tab identified by the Examiner is coplanar with a wall of the upper blade guard. Similarly, the second tab identified by the Examiner is coplanar with the plate. Thus neither tab extend outwardly and substantially perpendicular from the plate and/or the upper blade guard.

By contradistinction, Claim 13 requires that "at least one of the upper blade guard and plate have a first tab disposed near the screw and extending outwardly and substantially perpendicularly to the at least one of the upper blade guard and plate." the second distance be[ing] longer than [the] distance between the lower blade guard and the upper blade guard." Accordingly, Chen cannot anticipate Claim 13 and its dependent claims.

The Examiner rejected Claims 1-7 under 35 USC § 103(a) as being unpatentable over US Patent No. 6,431,042 ("Brault") in view of US Patent No. 4,226,151 ("Littley"). Reconsideration and withdrawal of this rejection are respectfully requested.

Admittedly, Brault has a base assembly, a table rotatably attached to the base assembly, a saw assembly pivotably attached to the table. The Examiner surprisingly now notes that Brault does not have a wear ring, even though in multiple Office Actions, the Examiner identified wear ring 110. Nonetheless, the Examiner points at Littley to provide such wear ring.

Serial No. 10/054,257

Amend. In Resp. to Office Action of Dec. 19, 2005

UTILITY PATENT

B&D No. TN -2239

Assuming for the sake of argument that it is proper for the Examiner to ignore Brault's wear ring 110, even if Brault and Littley were to be combined, the Brault/Littley combination would not show all claimed elements. This is because Littley's wear ring 86 does not contact both the table and the base.

By contradistinction, Claim 1 requires that the wear ring not have "a wear ring non-fixedly disposed between and contacting the base assembly and the table." Accordingly, the Brault/Littley combination cannot render unpatentable Claim 1 and its dependent claims.

No fee is believed due. Nonetheless, the Commissioner is authorized to charge payment of any fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance.

Respectfully submitted,



Adan Ayala, Reg. No. 38,373
Attorney for Applicants
Phone No. (410) 716-2368